

REMARKS

This application has been reviewed in light of the Office Action dated March 2, 2004. Claims 29-43 are presented for examination, of which Claims 29, 34, 39, and 46 are in independent form. Claims 29, 34, 39, and 46 have been amended to define Applicant's invention more clearly. Favorable reconsideration is requested.

According to page 2 of the Office Action, Claims 29-46 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent 6,167,441 (Himmel) in view of U.S. Patent 6,157,630 (Adler et al.). A review of the discussion of the reasoning underlying the rejection, however, leads to the belief that the secondary reference intended to be relied upon was not *Adler*, but U.S. Patent 5,951,636 (Zerber), first, because that discussion after the initial paragraph refers only to *Zerber* and not to *Adler*, and second, because the references to drawing figures and to portions of the specification of the reference, appear largely to fit with *Zerber*, but not with *Adler* (for example, at page 3, reference is made to col. 9, line 22, through col. 10, line 48, which columns in *Adler* end before reaching even line 12). Accordingly, the remainder of this discussion is premised on the understanding that the secondary reference actually relied upon is *Zerber*, not *Adler*. If that is not correct, the Examiner is requested to provide clarification in the next Office Action (which of course should be non-final if the rejection is maintained).

The aspect of the present invention set forth in independent Claim 29 is directed to a communication device for receiving an e-mail stored in an e-mail server, which device

comprises communication means for transmitting an e-mail transmission request to the e-mail server and receiving the e-mail transmitted from the e-mail server in response to the transmission request, and memory means for storing the e-mail received from the e-mail server. Also provided are acquisition means for acquiring from the e-mail server, before the communication means receives the e-mail from the e-mail server, size information of the e-mail located on the e-mail server, and determination means for determining, based on the size information of the requested e-mail acquired by the acquisition means and an available storage capacity of the memory means, whether the storage capacity of said memory means in the communication device is sufficient to store all data included in the e-mail. Also, according to Claim 29, if it is determined that the available storage capacity of the memory means is sufficient to store all the data included in the e-mail, the e-mail server transmits the e-mail entirely to the communications device, otherwise the e-mail server transmits only header data of the e-mail to the communications device. Also present are warning means that, if the determination means determines that the available storage capacity of the memory means of the communication device is not sufficient to store all the data included in the e-mail, visually outputting warning information to the communication device indicating that the e-mail stored in the e-mail server cannot be entirely received

Among other important features of Claim 29 believed clearly not to be taught or suggested by anything in the prior art relied upon by the Examiner, are the recited acquisition

means and the determination means. More particularly, Applicant submits that none of the art cited by the Examiner discloses (1) acquisition means for acquiring size information of an e-mail located on an e-mail server prior to transmission, or (2) determination means for determining whether the storage capacity of memory means of a communication device is sufficient to store all data included in such e-mail.

The Office Action associates the acquisition means of Claim 29 with the client-smart agent 155 (see Fig. 4) of *Himmel*. Applicant respectfully points out that the client-smart agent 155 of *Himmel* is a routine used by a WEB (HTTP) server to determine the proper HTML configuration and operating system of a client's device prior to transmission of HTML data. *Himmel*'s acquisition of such information attempts to ensure compatibility between the information transmitted and the receiving device (see col. 5, line 51, through col. 6, line 16). It is to be stressed that nothing has been found in *Himmel* that even suggests that the client-smart agent 155 of the server sends information to the client regarding the size of the file that is to be transmitted from the server to the client, prior to transmission: in fact, the task of the client-smart agent 155 is just the opposite, i.e., to obtain information from the client's device configuration prior to transmission (col. 5, lines 52-61).

Furthermore, the *Himmel* system determines the configuration of the client's device and based on that determination directs the client's request to the optimum HTML WEB page. *Himmel*'s determination of where to direct the client's request based on the information

obtained by the client-smart agent 155 is based solely on the configuration of the client device, and not on the size of the information requested.. After making its determination, the *Himmel* system directs the client to the appropriate HTTP server based on the client's device configuration and then transmits all of the data requested by the client device. *Himmel* does not parse the data or send header information based on the determination of the client-smart agent 155, it merely sends what ever data is requested based on the clients configuration. Unlike the apparatus of Claim 29, *Himmel* does not determine based on size information acquired by acquisition means and the available storage capacity of the client whether the memory means is sufficient to store all of the data included in the e-mail or whether to send just header information.

Still further, Applicant notes that the “dialog page” of *Himmel* is used to request information from the user to aid the client-smart agent 155 in determining which WEB page is optimized for the user's device. This is not believed to suggest, in any way, the warning means recited in Claim 29, which is used to alert the client that there is insufficient memory in the communication device to store the requested e-mail, and which is not recited as conveying communication device configuration information to the server.

For all these reasons, it is believed clear that Claim 29 is allowable over *Himmel* taken alone.

Moreover, even if *Zerber* is assumed to teach all that it is cited for, such would not supply what is missing from *Himmel* as a reference against Claim 29. Accordingly, that claim is believed to be clearly allowable over *Himmel* and *Zerber*, taken separately or in any permissible combination (if any exists).

Independent Claims 34 and 39 are respectively a method claim and a memory-medium claim corresponding to device Claim 29, and independent Claim 46 is directed to a device similar to Claim 29 in respect of the features discussed above. Claims 34, 39 and 46, therefore, are deemed allowable over the patents discussed above for reasons similar to those presented with regard to Claim 29.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application depend from one or another of the independent claims discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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